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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,304	07/22/2003	Masafumi Matsuda	S01459.70053.US	7805
7590 05/07/2007 Randy J. Pritzker Wolf, Greenfield & Sacks, P.C. 600 Atlantic Avenue Boston, MA 02210			EXAMINER LY, ANH	
			ART UNIT 2162	PAPER NUMBER
			MAIL DATE 05/07/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Interview Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/624,304	MATSUDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anh Ly	2162	

All participants (applicant, applicant's representative, PTO personnel):

(1) Anh Ly. (3) \_\_\_\_\_.

(2) Randy J. Pritzker (Reg. No.: 35,986). (4) \_\_\_\_\_.

Date of Interview: MON. 04/30/2007.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 1,9,10 and 18.

Identification of prior art discussed: Kajiyama et al. (2001/0006771) and Hori et al. (2002/0131594).

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.



Anh Ly

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicants' representative agreed to make amendment to overcome 101 issues and clarify the "reproduction status" by claim language in the claims. Examiner makes suggestions in order to make claims in good condition for allowable by incorporating the limitations of claims 8 and 21 into independent claim 1 and the same limitations of claims 8 and 21 into independent claims 9 (claims 27 & 30), 10 (claims 36 & 39) and 18 (claims 8 and 21) and reproducing fig.1 with clearly label in the drawing.



*Interviewed Mon 04/30/07 @ 1:30pm*  
*12*  
*Bohly*

**F A X C O V E R**

**Date** Tuesday, April 10, 2007 **Number of pages** (including cover): 6

**To** Examiner Ly

**Company** USPTO

**Your File #** 10/624,304

**Tel** 571-272-4039

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**From** David Gesner for Randy Pritzker

**Direct dial** 617-646-8341

**Our File #** S1459.70053US00

ORIGINAL DOCUMENTS SENT: ☐ 1st Class Mail ☐ Overnight Mail ☐ Air Mail ☐ Not Sent

**MESSAGE:**

Applicant's representatives would like to discuss the attached in a telephone interview.

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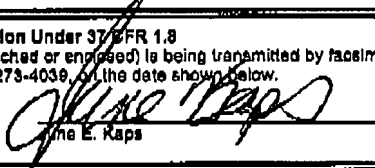
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**PATENTS TRADEMARKS COPYRIGHTS TECHNOLOGY TRANSFERS LITIGATION**

Docket No.: S1459.70053US00  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Masafumi Matsuda et al.  
Serial No.: 10/624,304  
Confirmation No.: 7805  
Filed: July 22, 2003  
For: DATA PROCESSING APPARATUS, DATA PROCESSING  
METHOD, DATA PROCESSING SYSTEM, STORAGE MEDIUM  
AND PROGRAM  
Examiner: A. Ly  
Art Unit: 2162

Certificate of Transmission Under 37 CFR 1.8	
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to Examiner A. Ly, Group Art Unit 2162, U.S. Patent and Trademark Office, facsimile no. (871) 273-4039, on the date shown below.	
Dated: 4/10/07	
John E. Kaps	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**INTERVIEW AGENDA – NOT FOR ENTRY**

In response to Examiner Ly's request, a proposed agenda for a telephone interview follows. Examiner Ly has requested a proposed agenda before agreeing to grant the telephone interview.

Applicants' representatives request the interview to discuss claim rejections under 35 U.S.C. §101, §112 and §103, as follows:

I. Rejections under 35 U.S.C. §101

A. Claims Rejected For Purportedly Failing To Satisfy The Utility Requirement

Claims 1-6, 8-10 and 18-39 are rejected under 35 U.S.C. §101 for purportedly "lacking of real world useful result." Specifically, the Office Action contends that these claims "are missing the steps or processes producing any useful result to the invention."

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Claims 1-6, 8-10 and 18-39 are believed to satisfy the utility requirement. M.P.E.P. §2107(II)(B)(1) provides that "[i]f the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., that it has a "specific and substantial utility") and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility." A specific utility is one that "is specific to the subject matter claimed and can "provide a well-defined and particular benefit to the public." M.P.E.P. §2107(.01)(I)(A). "[T]o satisfy the 'substantial' utility requirement, an Applicant must show that the claimed invention has a significant and presently available benefit to the public." M.P.E.P. §2107(.01)(I)(B).

It is believed that the invention recited by each of claims 1-6, 8-10 and 18-39 has a specific and substantial utility. For example, claim 1 produces a result of transmitting a list showing a content data item which is selected from a plurality of content data items depending on its reproduction status. This result provides a benefit to the public which is both well-defined and particular (and thus "specific") and significant and presently available (and thus "substantial").

Accordingly, Applicant's representatives wish to discuss why the Examiner believes claims 1-6, 8-10 and 18-39 are "lacking of real world useful result."

**B. Claims Rejected For Purportedly Reciting Non-Statutory Subject Matter**

Claims 10 and 31-39 are rejected for purportedly reciting non-statutory software *per se*. Claim 10 recites at least one computer-readable medium having instructions encoded thereon which, when executed, perform a process comprising a plurality of steps including transmitting a list.

The Office Action contends that because one step in the process is to transmit a list, the computer readable medium recited by claim 10 comprises a transmission signal, which the Office Action alleges is non-statutory subject matter. The Office Action also contends that the list that is transmitted comprises descriptive material, which itself is non-statutory subject matter.

Without acceding to the propriety of the rejection, Applicant's representatives propose to amend claim 10 to recite an article of manufacture comprising at least one computer-readable

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medium having instructions encoded thereon, and wish to discuss with the Examiner whether this proposed amendment would overcome the rejection of claim 10 and 31-39 under §101.

II. Rejections under 35 U.S.C. §112

Claim 18 is rejected under 35 U.S.C. §112, first paragraph, for purportedly failing to comply with the written description requirement. Specifically, the Office Action contends that limitations requiring a "first reproducing unit" and "second reproducing unit" lack support in the specification or drawings.

Applicant's representatives wish to discuss the basis for this rejection with the Examiner, as it is believed that these limitations find support in the specification and drawings. For example, FIG. 1 depicts portable terminals 11-1 through 11-6 (see, e.g., Applicant's specification at p. 12, lines 10-12). Functions implemented by each of portable terminals 11-1 through 11-6 are shown in the functional block diagram of Fig. 3 (p. 15, lines 10-12). For example, each portable terminal includes a "reproduction unit" that reproduces tunes stored in a storage unit (p. 16, lines 1-3). Because each portable terminal includes a reproduction unit, each portable terminal may be considered a "reproducing unit," as recited by claim 18. Fig. 1 depicts multiple reproducing units (i.e., portable terminals 11-1 through 11-6), such that one of the reproducing units may be considered a "first reproducing unit" and another may be considered a "second reproducing unit."

Accordingly, Applicant's representatives wish to discuss why the Examiner believes the limitations of claim 18 lack support in the specification or drawings.

III. Rejections under 35 U.S.C. §103

1-10 and 18-39 are rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over U.S. Patent Publication No. 2001/0006771 to Kajiyama et al. ("Kajiyama") in view of U.S. Patent Publication No. 2002/0131594 to Hori et al. ("Hori"). Without acceding to the propriety of the

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asserted combination, Applicant's representatives wish to propose amendments to each of claims 1-10 and 18-38 which patentably distinguish over the prior art of record. A marked-up version of claim 1 is provided below to illustrate proposed amendments to each independent claim:

1. A data processing apparatus comprising:  
a reproducing unit configured to reproduce a plurality of content data items;  
a control unit configured to detect a reproduction status of each content data item ~~being~~  
when said each content data item is reproduced by said reproducing unit, and to select a  
recommendation content data item from said plurality of content data items depending on a  
reproduction status of said recommendation content data item; and  
a communication unit configured to transmit to another data processing apparatus a list  
which shows said selected recommendation content data item.

Neither Kajiyama nor Hori discloses or suggests the limitations recited by amended claim 1. For example, Kajiyama, which the Office Action cites as purportedly meeting all of the limitations of claim 1 except for a communication unit configured to transmit to another data processing apparatus, fails to disclose or suggest detecting a reproduction status of a plurality of content data items *when each content data item is reproduced*. Rather, Kajiyama discloses a method which employs pre-recorded reproduction management information. Kajiyama also does not disclose or suggest selecting a *recommendation content data item* depending on a reproduction status. Kajiyama does not disclose a recommendation content data item which is selected depending on its reproduction status.

Applicant's representatives wish to discuss these proposed amendments in light of the prior art of record, and to discuss whether the Examiner would be amenable to entering the amendments under 37 C.F.R. §1.116.



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Applicants' representatives thank Examiner Ly for agreeing to review this proposed agenda. If the Examiner has any questions concerning the foregoing, he is invited to contact the undersigned at the number provided below.

Dated: 4-10-07

Respectfully submitted,

By Randy J. Pritzker  
Randy J. Pritzker  
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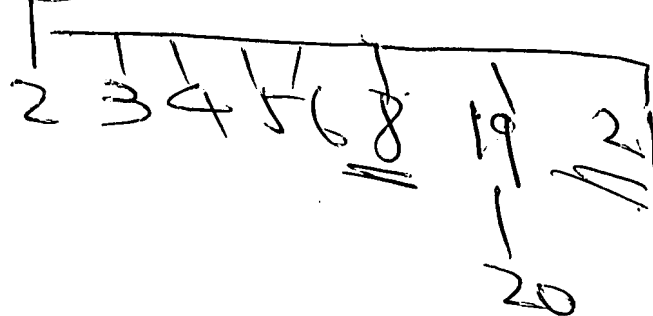
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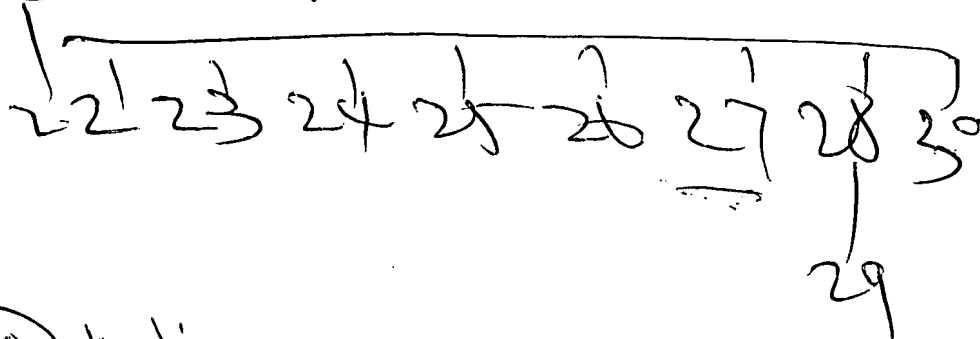
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07/22/02

Cancelled:  
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11-17

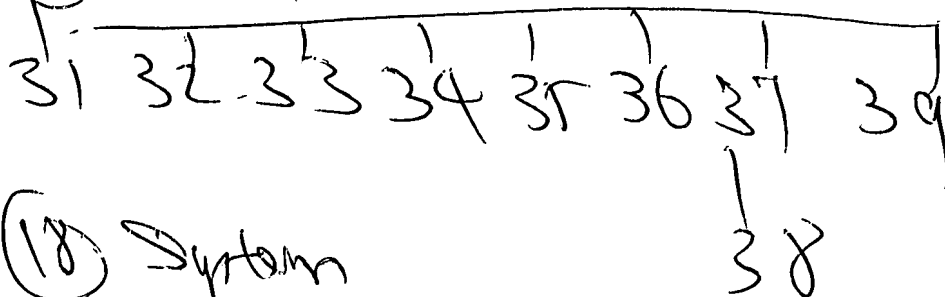
(1) 12 data processing apparatus



(9) Method



(10) medium



(18) System